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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/209,454	12/11/1998	HIDENARI TANAKA	88125/ASAHI	6958

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EXAMINER

LASTRA, DANIEL

ART UNIT	PAPER NUMBER
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3622

DATE MAILED: 09/25/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/209,454

Applicant(s)

TANAKA ET AL.

Examiner

DANIEL LASTRA

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 March 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 15-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 15-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 6/5/0 is: a) ☒ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

1. Claims 15-20 have been examined.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 15-17 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schlueter, Jr. et al (U.S. 5,974,124) in view of Eggleston et al (U.S. 6,061,660).

As per claim 15, Schlueter, Jr. et al. teach:

A method of selling prescription contact lenses comprising:

“transferring a customer identification, address, and diagnostic data pertaining to a customer from a physician to a contact lens provider through a communication network (see abstract). Schlueter does not teach that the remote computer 100 is located in the contact lens provider, however the transmitting steps would be performed the same regardless of the data and the location of the information processing apparatus. Thus, this descriptive material would not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994). It would have been obvious to a person of ordinary skill in the art at the time the application was made, to collect different types of diagnosis data from a customer and to transmit or receive diagnosis data from one processing apparatus to another.

The subjective interpretation of the data does not patentably distinguish the claimed invention from the prior art.

Schlueter does not expressly teach, "assigning a registration number to the customer and storing the registration number assigned in relationship with the customer identification and diagnostics data transferred to the provider. However, lines 38-44 of column 2 teach of medical readings taken in the medical office that are uploaded to a centralized database via the Internet. When the Internet is used, adequate security precautions would be taken to prevent unauthorized access to the information. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that to transmit data via the Internet, the Schlueter system would register its users and assign passwords to them, as this is a well known method to control access to customer data over the Internet.

Schlueter does not teach, "providing the registration number assigned and selling agent locality data in geographical relation to the customer address data from the contact lens provider to the customer through the communication network and providing the registration number, the customer identification data, and the diagnostic data from the contact lens provider to a selling agent through the communication network".

However, Eggleston teaches a system that registers its customers and compares the geographic information of the consumer with selling localities to identify the nearest selling locality for the fulfillment of incentives (see column 22, lines 1-6). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that the Schlueter system would transmit the customers'

addresses and diagnostic data to a central computer to contact the nearest located sellers, as taught by Eggleston.

As per claim 16, Schlueter, Jr. et al fail to teach:

The method of Claim 15, wherein a service charge is paid by the contact lens provider to the selling agent upon monthly payment by the customer". However, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that contact lens manufacturers would give commissions to selling agent that serve as intermediaries between customers and providers, as an incentive for sellers to sell the contact lens to providers. This feature would be a business decision that would not patentably distinguish the claimed invention from the prior art.

As per claim 17, Schlueter, Jr. et al. teach:

A method of selling prescription contact lenses comprising:

"transferring a customer identification, address, and diagnostic data pertaining to a customer from a physician to a contact lens provider through a communication network (see abstract). Schlueter does not teach that the remote computer 100 is located in the contact lens provider, however the transmitting steps would be performed the same regardless of the type of data and the location of the information processing apparatus. Thus, this descriptive material would not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994). It would have been obvious to a person of ordinary skill in the art at the time the application was made, to collect different types of diagnosis data from a customer

and to transmit or receive diagnosis data from one processing apparatus to another. The subjective interpretation of the data does not patentably distinguish the claimed invention from the prior art.

Schlueter does not expressly teach, "assigning a registration number to the customer and storing the registration number assigned in relationship with the customer identification and diagnostic data transferred to the provider". However, lines 38-44 of column 2 teach of medical readings taken in the medical office that are uploaded to a centralized database via the Internet. When the Internet is used, adequate security precautions would be taken to prevent unauthorized access to the information. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that to transmit data via the Internet, the Schlueter system would register its users and assign them passwords as this is a well known method to control access to customer data over the Internet.

Schlueter does not expressly teach, "providing the registration number assigned and selling agent data for a selling agent closest in geographical relation to the customer based on the customer address data, from the contact lens provider to the customer, through the communication network, delivering a contact lens from the selling agent to the customer and transferring delivery data from the selling agent to the contact lens provider through the communication network".

However, Eggleston teaches a system that register its customers and compares the geographic information of the consumer with selling localities to identify the nearest selling locality for the fulfillment of incentives (see column 22, lines 1-6). Therefore, it

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would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that the Schlueter system would transmit the customers' addresses and diagnostic data to a central computer to contact the nearest located sellers and to deliver the contact lens to the customer, as taught by Eggleston. Eggleston does not expressly teach of contact lenses but the transferring of information and the selling of products would be performed the same regardless of the type or kind of data being processed. Thus, this descriptive material would not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994). It would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that although Eggleston does not mention contact lenses, its invention would apply to any kind of product or incentive. The subjective interpretation of the data does not patentably distinguish the claimed invention from the prior art.

As per claim 20, Schlueter, Jr. et al fail to teach:

The method of claim 17, including periodically offering for sale contact lens care articles by the contact lens provider to the customer through the communication network". However, Eggleston teaches a system that provides incentive products via the Internet (see summary of the invention). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that contact lenses would be incentive products, and that Schlueter would use the Eggleston invention to deliver contact lenses to customer if it wishes to do so.

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Claims 18 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schlueter, Jr. et al (U.S. 5,974,124) in view of Eggleston et al (U.S. 6,061,660) and further in view of Dziabo, Jr. et al (U.S. 5,213,760).

As per claim 18, Schlueter, Jr. et al fail to teach:

The method of claim 17, including delivering notification of an approaching deadline to replace the contact lens from the contact lens provider to the customer through the communication network". However, Dziabo, Jr. et al teach that a major problem with contact lenses is that patients do not dispose of the lenses pursuant to the manufacturer's instructions (see column 1). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that a contact lens provider would use the Schlueter invention to deliver a notification to the patient of an approaching deadline to replace the contact lens as the health of the patients may be at risk.

As per claim 19, Schlueter, Jr. et al do not teach:

The method of Claim 18, including offering new contact lenses to the customer in exchange for old contact lenses and a monthly payment by the user". However, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that it would be a business decision to offer new contact lenses as a substitute for old ones by charging a monthly fee. This feature would not patentably distinguish the claimed invention from the prior art.

Response to Arguments

3. Applicant's arguments filed 03/11/02 have been fully considered but they are not persuasive.

The Applicant argues that there is nothing in the prior art Schlueter about merchandizing contact lenses.

The Examiner answers that Eggleston teaches a system that registers its customers and compares the geographic information of the consumer with selling localities to identify the nearest selling locality for the fulfillment of incentives (see column 22, lines 1-6). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that the Schlueter system would transmit customers' addresses and diagnostic data to a central computer to contact the nearest located sellers, as taught by Eggleston. Although neither Schlueter nor Eggleston mention contact lens provider, the transmitting steps would be performed the same regardless of the data and the location of the information processing apparatus. Thus, this descriptive material would not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994). It would have been obvious to a person of ordinary skill in the art at the time the application was made, to collect different types of diagnosis data from a customer and to transmit or receive diagnosis data from one processing apparatus to another. The subjective interpretation of the data does not patentably distinguish the claimed invention from the prior art.

Conclusion

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **DANIEL LASTRA** whose telephone number is 703-306-5933. The examiner can normally be reached on 7:30-3:30.

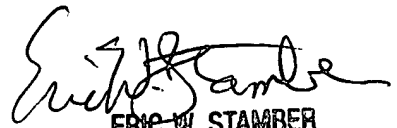
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **ERIC W STAMBER** can be reached on 703-305-8469. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9326 for regular communications and 703-872-9327 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

D.L.

Daniel Lastra

September 21, 2002


ERIC W. STAMBER
SUPERVISORY PATENT EXAMINER
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